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09/815,858

### REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 6, 2003. Favorable action is requested.

#### Amendment to the Drawings and the Specification

The Office Action objects to the drawings with the argument that the "logic" and the "computer-processable medium" stated in Claims 27-29 are not shown in the drawings. In response, Applicants amend FIGURE 2 to include software instructions 290, 292, 294, and 296 in memories 253, 249, 251, and 247, respectively. The specification has been amended accordingly to refer to software instructions 290, 292, 294, and 296. Applicants respectfully submit that an embodiment of a "logic" is shown by software instructions 290, 292, 294, and 296, and that an embodiment of a "computer-processable medium" is shown by memories 253, 249, 251, and 247. Favorable action is requested.

The Office Action also rejects the present drawings with the argument that the drawings fail to show "the computer," which the Office Action argues is "... essential for a proper understanding of the disclosed invention." (Paragraph 4, Office Action). Applicants respectfully traverse this objection because none of the pending claims use the term "computer" to state a limitation, and the specification does not identify any computing apparatus as essential for any embodiment of the present invention. Regardless, numerous computing apparatuses are identified in FIGURE 2. For example, gatekeeper 228 shown in FIGURE 2 is a computing apparatus because it is shown as having a memory 249 and a processor 250. Further, the specification states that "[m]emory 249 may store software instructions executed by processor 250 to perform the described functions of gatekeeper 228." (See page 11, line 31 through page 12, line 2 of present Application.) Thus, Applicants respectfully submit that objections to the drawings are improper and should be withdrawn. Reconsideration and favorable action are requested.

#### §112 Rejections

The Office Action rejects Claims 27-29 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention because, states the Office Action, "the specification fails to provide an enabling disclosure for the logic encoded on the computer-processable medium since this 'logic' is not disclosed and is only known to the

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inventor." This is incorrect because on page 20, lines 9-14, the present Application states that "[i]n another embodiment, the functions of one or more of these components [for example, WARP 210, gateway 216, gatekeeper 228, and subscriber location register 230] may be incorporated into logic encoded on at least one computer-processable medium. The logic may be encoded in hardware, software instructions, and/or firmware instructions stored in any suitable device such as, for example, a random access memory (RAM), a read only memory (ROM), an application specific integrated circuit (ASIC), or a field programmable gate array (FPGA)." Example embodiments of the functions of components described in the present Application are shown in FIGURES 3-5B and described in pages 20-25. Providing flow charts, such as the ones in FIGURES 3-5B, is sufficient to satisfy the enablement requirement in cases concerning software instructions, such as logic, because such a flow chart provides the functional acts and the relationship between those acts that allow one skilled in the art to implement the acts using software, hardware, or other suitable device. Thus, Applicants submit that the specification indeed provides an enabling disclosure of "logic" for one skilled in the art to practice the invention. Reconsideration and favorable action are requested.

The Office Action also states that Claims 27-29 are rejected under § 112, Paragraph 1, because, states the Office Action, the "mobile station" and the "private network" are "critical or essential to the practice of the invention, but not included in the claims [and] is not enabled by the disclosure." The Office Action further states that "a computer processable medium and the logic encoded on computer processable medium cannot operate as a system for providing messages services." To advance the prosecution of this case, Applicants amend the preamble of Claims 27-29 to read "A system for providing message services through a private network and a mobile station, comprising; . . . ." As clarified by the amended preambles of Claims 27-29, each invention claimed in Claims 27-29 is directed to a system that is independent from a private network and a mobile station but may be used in conjunction with a private network and a mobile station to provide message services. Thus, the private network and the mobile station do not need to be included as claim limitations for the respective inventions of Claims 27-29. Further, the specification does not teach or suggest that a private network and a mobile station are essential to any embodiments of the present invention, and the description of FIGURE 2 provides an enabling disclosure of a private network and a mobile station for one skilled in the art (see pages 8-20 of the present application). Reconsideration and favorable action are requested.

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The Office Action rejects Claims 27-29 also under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential elements. The Office Action states that "the mobile station" and the "private network" are essential elements and that they are omitted from Claims 27-29. However, as stated above, nothing in the present Application states that the mobile station and the private network are essential elements. In fact, as described above, some embodiments of the inventions in Claims 27-29 are directed to systems that are independent from a private network and a mobile station but may be used in conjunction with a private network and a mobile station to provide message services. As such, the mobile station and the private network are not essential elements and the §112, second paragraph rejection is improper. Reconsideration and favorable action are requested.

### §103 Rejections

The Office Action rejects Claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,825,883 to Archibald, et al ("*Archibald*") in view of U.S. Pat. No. 6,571,108 to Otsuka, et al. ("*Otsuka*"). Applicants respectfully traverse these rejections for reasons stated below.

Claim 18 is allowable over a combination of *Archibald* and *Otsuka* because the combination does not teach or suggest "assigning a user identifier to a first mobile station identifier corresponding to a first mobile station in a private network . . .," as recited by Claim 18. FIGURE 2 of *Archibald* shows "a user ID 92," but does not show a mobile station identifier in a private network. The Examiner concedes that this limitation is missing. While the portion of *Otsuka* identified in the Office Action as showing a mobile station identifier describes ". . . an ID unique in the network of the radio terminal," nothing in either *Archibald* or *Otsuka* teaches or suggests "assigning a user identifier to a first mobile station identifier corresponding to a first mobile station . . ." [emphasis added]. In fact, the Office Action contains no assertion that a combination of the cited references teaches the missing limitation. Instead, the Office Action merely states that it would have been obvious to modify the teachings of *Archibald* to use a mobile station identifier in a private network of *Otsuka* so that messages can also be provided in private networks. (" . . . it would have been obvious for one of ordinary skill in the art . . . to incorporate the use of mobile station identifier in a private network, as taught by *Otsuka, et al.*, [to] specifically identify[ing] the mobile station . . . *Archibald, et al.* in order to provide messages also in private networks." - pg 4, Office Action) However, nothing in the Office Action asserts that

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the use of the ID of *Otsuka* in conjunction with the user ID of *Archibald*, as proposed in the Office Action, shows "assigning a user identifier to a first mobile station identifier . . ." In one embodiment, assigning a user identifier to a first mobile identifier allows ". . . messages . . . [to be] sent to a mobile station based on an identifier for the user of the mobile station rather than based on an identifier for the mobile station itself, such that a sender need not have knowledge of the identifier for the mobile station." (See page 2, lines 4-7 of the present application). Because the proposed combination of the cited references does not show the missing limitation and nothing in the Office Action asserts that the combination shows the missing limitation, Claim 18 is allowable.

Even if the Office Action included such an assertion, which it does not, nothing in the Office Action constitutes a showing that the combination of the cited references is proper. As stated repeatedly in many portions of the M.P.E.P., including §2143.01, "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." [emphasis added]. Further, the same section of the M.P.E.P. specifically states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." While the Office Action asserts that *Archibald* describes using "user ID 92" and that it would be obvious for a skilled artisan modify the teachings of *Archibald* to use "an ID" of *Otsuka* so that messages can be sent in a private network, the Office Action neither identifies any portion of the references that explicitly or implicitly show a motivation to combine the references nor makes a sufficient showing to establish that such a combination is within the knowledge generally available to one of ordinary skill in the art. Without more, the argument presented in the Office Action only provides PTO speculation<sup>1</sup> that the references can be combined, which is explicitly stated in the M.P.E.P. as insufficient for a proper obviousness rejection. Thus, Claim 18 is allowable. Reconsideration and favorable action are requested.

<sup>1</sup> See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention).

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As depending from allowable independent Claim 18, dependent Claims 19-26 are also allowable. Claim 19 is allowable also because none of the cited references teaches or suggests assigning a user identifier to a first mobile station identifier where "the user identifier . . . [comprises] at least one of a first name, a last name and a nickname for the recipient," as recited by Claim 19. Claim 22 is allowable also because none of the cited references teaches or suggests "assigning the user identifier to a second mobile station identifier corresponding to a second mobile station in the private network . . .," as recited by Claim 22. Reconsideration and favorable action are requested.

Claim 1 is allowable for reasons analogous to those provided in conjunction with Claim 18. More specifically, none of the cited references teaches or suggests ". . . the user identifier assigned to the mobile station identifier in the private network," as recited by Claim 1. Reconsideration and favorable action are requested.

Claim 12 is allowable for reasons analogous to those provided in conjunction with Claim 18. More specifically, none of the cited references teaches or suggests "determining a mobile station identifier based on the user identifier [operable to identify the recipient]," as recited by Claim 12. Reconsideration and favorable action are requested.

As depending from their respective allowable independent Claims 1 and 12, dependent Claims 2-11 and 13-17 are also allowable. Reconsideration and favorable action are requested.

Claim 27 is allowable for reasons analogous to those provided in conjunction with Claim 18. More specifically, none of the cited references teaches or suggests "logic . . . operable to . . . receive a user identifier . . . [that is] assigned to the mobile station identifier in the private network," as recited by Claim 27. Reconsideration and favorable action are requested.

Claim 28 is allowable for reasons analogous to those provided in conjunction with Claim 18. More specifically, none of the cited references teaches or suggests "logic . . . operable to . . . determine a mobile station identifier based on the user identifier [operable to identify the recipient of the message]," as recited by Claim 28. Reconsideration and favorable action are requested.

Claim 29 is allowable for reasons analogous to those provided in conjunction with Claim 18. More specifically, none of the cited references teaches or suggests "logic . . . operable to assign a user identifier to a first mobile station identifier corresponding to a first mobile station in a private network, . . . to assign the user identifier to a second mobile

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station identifier corresponding to a second mobile station in the private network," as recited by Claim 29. Reconsideration and favorable action are requested.

Claim 30 is allowable for reasons analogous to those provided in conjunction with Claim 18. More specifically, none of the cited references teaches or suggests "means for assigning a user identifier to a first mobile station identifier corresponding to a first mobile station in a private network," as recited by Claim 30. Reconsideration and favorable action are requested.

Claim 31 is allowable because none of the cited references teaches or suggests "receiving a non-address identifier for a recipient of a user notification message, the non-address identifier being non-unique in the private network," as recited by Claim 31. The Office Action appears to state that "an ID unique in the network of the radio terminal . . ." shown in *Otsuka* shows this limitation. This is incorrect because the ID described in the portion of *Otsuka* identified in the Office Action as showing this missing limitation in fact specifically states that the ID is "unique in the network of the radio terminal." (See Column 4, lines 29-31 of *Otsuka*), which is opposite from an "identifier" of Claim 31 that is "non-unique in the private network." Thus, Claim 31 is allowable. Reconsideration and favorable action are requested.

As depending from allowable independent Claim 31, dependent Claims 32 and 33 are also allowable. Claim 32 is allowable also because none of the cited references teaches or suggests "providing the sender of the message with non-address identifiers as choices for selection, the non-address identifiers associated with the sender . . ." as recited by Claim 32. Claim 33 is allowable because none of the cited references teaches or suggests "determining a plurality of address identifiers based on the sender of the message and the non-address identifier; and addressing the message with the address identifiers for multiple deliveries to the recipient in the private network." Reconsideration and favorable action are requested.

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CONCLUSION

For the foregoing reasons and for reasons clearly apparent, Applicants respectfully request allowance of all pending claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 19-2179 of Siemens Information & Communications Products, L.L.C.

Date: Feb: 5, 2004

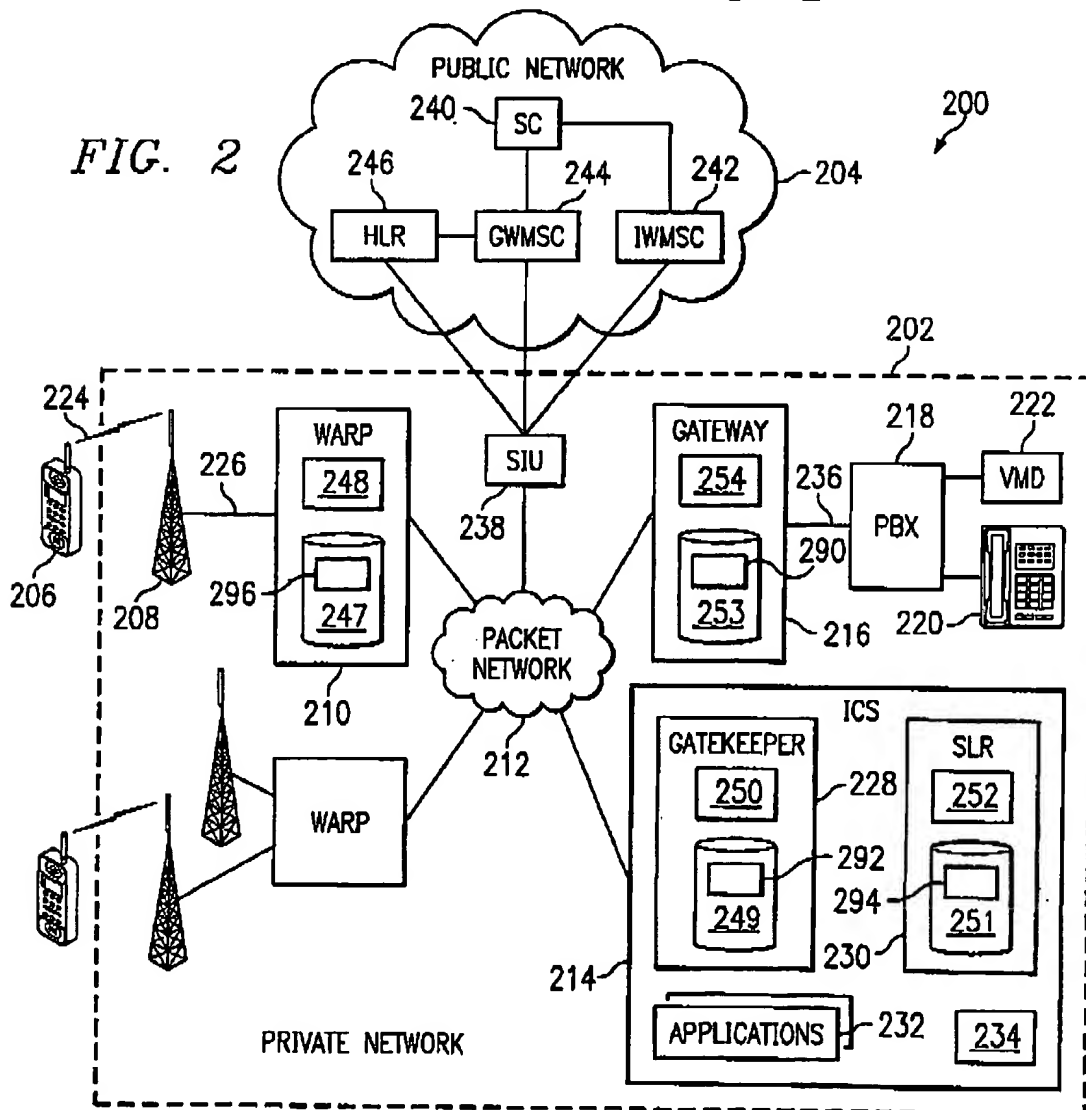
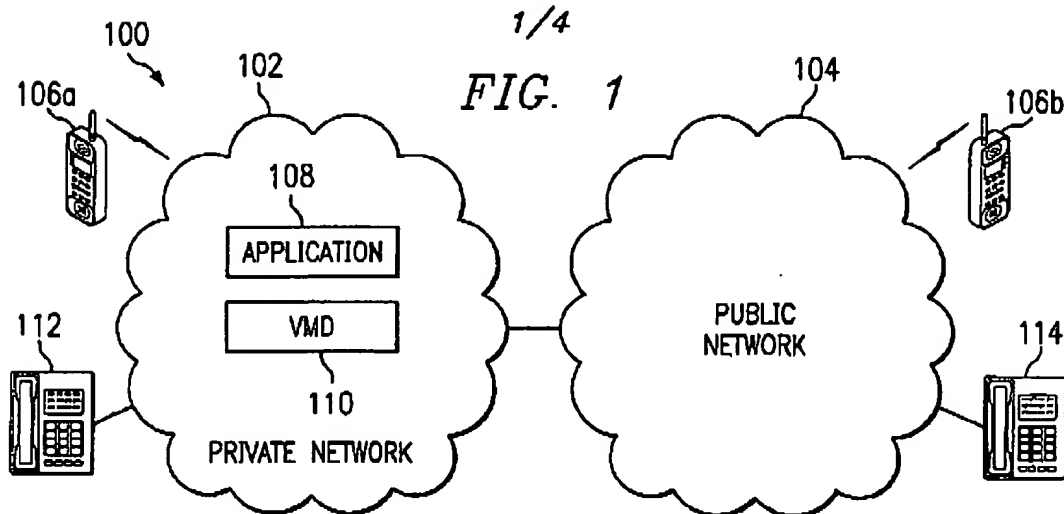
Respectfully requested,

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REPLACEMENT  
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ANNOTATED  
MARKED-UP  
DRAWINGS